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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,225	06/08/2000	Takahiro Nakahigashi	107351-00001	2429

7590

05/19/2003

Arent Fox Kintner Plotkin & Kahn PLLC
Suite 600
1050 Connecticut Avenue NW
Washington, DC 20036-5339

EXAMINER

TURNER, ARCHENE A

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/19/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-19

Office Action Summary	Application No. 09/589,225	Applicant(s) NAKAHIGASHI ET AL.	
	Examiner Archene Turner	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-12,14,15,18,19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4,5,7-12,14,15 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 18,19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 18 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. the phrase 'other than a tire' in claim 18 and 'other than an image forming apparatus' is not explicitly disclosed in the original specification. The applicant is reminded that a negative limitation recited in the present claims, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 USC 112, (In re Anderson, 471 F. 2d. 1237, 176 USPQ 331 (CCPA 1973)).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Petrmichl et al (5,618,619).

Petrmichl et al discloses a carbon coating on substrates like plastics, that need protection but need to maintain their flexibility (column 5, 34-49). An automobile part such as a convertible top (column 1, line 38-40) is disclosed as an example. A bar scanner (column 1, line 11) is another example of a machine part. Applicant's arguments filed 2-24-03 have been fully considered but they are not persuasive. The negative limitation now in the claim is considered new matter, and thus the rejection stands. Petrmichl clearly discloses the claimed carbon coating on the claimed substrates and thus the rejection stands.

5. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Minolta (JP 64-090484).

Minolta discloses a carbon coating on a wiper blade. Applicant's arguments filed 2-24-03 have been fully considered but they are not persuasive. The negative

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limitation now in the claim is considered new matter, and thus the rejection stands.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Showa Denko (JP 04 136172) in view of Nakahigashi et al (5,562,952) or TDK (abstract of JP 04 041672) or Yamazaki et al (5,230,930) or Itoh (4,996,079) or Thaler (4,981,717).

Showa Denko discloses the use of carbon coating on pipes, but not polymeric ones. The examiner takes official notice that pipes made of polymer are known in the art. Nakahigashi et al or TDK or Yamazaki et al or Itoh or Thaler show that carbon coating are known on polymeric substrates to provide protection.

Thus it would have been obvious to one of ordinary skill in the art, to provide polymeric pipes with a protective carbon coating.

Applicant's arguments filed 2-24-03 have been fully considered but they are not persuasive. the applicant is reminded that one cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references (In re Young, 159 USPQ 725 (CCPA 1968)). Showa Denko discloses the known use of diamond coatings on pipes, and polymeric

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pipes are known in the art. The secondary references disclose the known use of carbon coatings on polymeric substrates to provide protection. It would have been obvious to one of ordinary skill to combine the first and secondary references to provide the claimed invention, and thus the rejection stands.

8. Claim 21 is allowed. Applicant's argument filed 2-24-03, with respect to the previous rejection, has been fully considered and is persuasive.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


10. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Archene Turner, whose telephone number is (703) 308-

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4344. The Examiner can normally be reached Monday to Thursday from 8:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 2, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1775. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1775.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



A. A. Turner
Primary Examiner
Group 1700

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